

DOCKET NO.: 198487US0X PCT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF :
Ryuzo TOMOMATSU et al : GROUP ART UNIT: 1713
SERIAL NO.: 09/674,498 : EXAMINER: Rip LEE
FILED: November 13, 2000 : ALLOWED: February 20, 2003
FOR: PROPYLENE RESIN COMPOSITION AND INTERIOR
AUTOMOTIVE MEMBER COMPRISING THE SAME

PETITION TO THE COMMISSIONER
AND WITHDRAW FROM ISSUE

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OFFICE OF PETITIONS

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

SIR:

Applicants petition the Commissioner under C.F.R. §1.181(3) that the above-identified application, allowed February 20, 2003, be removed from issue and returned to the Examiner for reconsideration of the stated reasons for allowance, and for such other action as may be appropriate.

REMARKS

It is Petitioners' position that the Examiner's stated reasons for allowance of the claims cast a cloud upon the validity of the patent containing the allowed claims. The reason is developed below.

HISTORY OF THE PROSECUTION

In the first action upon the merits of the application, Claims 1 and 3 were rejected under 35 U.S.C. §102(b) as anticipated by, or, in the alternative, under 35 U.S.C. §103(a) as

obvious over U.S. Patent No. 6,034,165 to Tomomatsu et al. Claim 1 was drawn to a composition containing a "propylene-based resin" (A).

Claim 2 was indicated to be allowable if rewritten to be in independent form. Claim 2 depended from Claim 1.

Claim 2 read as follows:

2. The propylene-based resin composition according to claim 1, wherein the solubles (b) has an ethylene unit content of 33 to 39% by weight.

In response, Applicants amended Claim 1 to contain the substance of Claim 2, which was deleted.

The next Official Action was a Notice of Allowability which contains an Examiner's reasons for allowance, including the following statement, referring to the disclosure in the applied Tomomatsu et al U.S. patent (underlining supplied).

Since the ethylene content of the entire propylene-based resin is only 1-17 wt%, the ethylene content of the p-xylene solubles fraction can not lie within the range of 33-39 wt%, as presently claimed. Therefore, the prior art does not teach the subject matter of the present invention.

The reasoning is obviously incorrect. To paraphrase the statement, one might say that since the oil content of an oil in vinegar salad dressing is only 1-17 wt.%, the oil content in the oil soluble fraction cannot be in the range of 33-39 wt.% or even 100%.

The following calculation, based on the disclosure in the application, demonstrates that the reasoning is incorrect. Referring to the propylene-based resin of Example 1, Table 1, of the subject application, the ethylene content of the p-xylenes soluble fraction is 37 wt.%. The fraction is 17% of the whole. Hence, the ethylene content of the whole may be $17 \times 37\% = 6.29\%$, which is within the range of 1-17%.

It is, therefore, not true that an ethylene content of 1-17 wt.% for the whole precludes an ethylene content of 33-39 wt.% for the fraction. The xylene solubles fraction of the Tomomatsu patent is 2-30% of the whole, preferably 9-20%, based upon the disclosure in the paragraphs bridging columns 2-3. This encompasses the 17% of the subject Example 1.

Petitioners view the Examiner's reasoning as creating doubt concerning the validity of the patent containing the claims as allowed.

Hence, Petitioners request that the application be removed from issue for the Examiner's reconsideration.

ALTERNATIVE REMEDIES

Alternative remedies are not sufficient.

The application file will generally not be returned to the Examiner after entry of comments made by an applicant and the Examiner has no obligation to review or comment on the same, M.P.E.P. (8th Ed., Rev. 1) § 1302.14.

A Request for Continued Examination is not appropriate since it is both expensive and the reason for the request is neither an argument required in support of patentability, nor any reason arising from Applicants' special knowledge.

Petitioners accordingly request the Commissioner to grant Applicant's Petition as stated above.

The required fee of \$130.00 is enclosed herewith by check and any further charges may be made against the Attorney of Record's Deposit Account No. 15-0030. A duplicate copy of this Petition is attached.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Norman F. Oblon
Attorney of Record
Registration No. 24,618

Milton Serman
Registration No. 27,499

Frederick D. Vastine, Ph.D.
Registration No. 27,013



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Tel.: (703) 413-3000
Fax: (703) 413-2220
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